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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,123	01/25/2006	Joachim Sprattc	72073	4210
23872	7590	09/18/2007	EXAMINER KENNEDY, JOSHUA T	
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			ART UNIT 3679	PAPER NUMBER
		MAIL DATE 09/18/2007	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/566,123	SPRATTE ET AL.
	Examiner	Art Unit
	Joshua T. Kennedy	3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
  - 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 19-29 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: ____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: ____	6) <input type="checkbox"/> Other: ____

## DETAILED ACTION

Claims 1-7 and 19-29 have been examined.

Claims 8-18 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/2/2007.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ersoy et al (US Patent 7,063,480) in view of Nishino et al (US Patent 6,831,629).

As to Claims 1, 5-7, 21 and 23. Ersoy et al disclose a ball and socket joint for a motor vehicle, the ball and socket joint comprising:

a ball and socket joint housing (4);

a ball pivot which is mounted rotatably and pivotably in said housing and has a pivot (3) and a joint ball (1) connected thereto, said ball pivot having a recess (Fig 1); and

a magnet (M) arranged in said recess.

However, Ersoy et al do not disclose wherein an intermediate space, which is filled with a hollow, cylindrical plastic ring to fix said magnet, being formed between a jacket surface of said magnet and an inner wall of said recess and said magnet being embedded in said plastic ring.

Nishino et al disclose a pivot joint having a hollow, cylindrical plastic ring (200; Col 26, Line 64) "for accommodating [a] magnet" (Col 25, Lines 29-53) which is placed into a recess of a pivotable structure (194, 230). It would have been obvious to one of ordinary skill in the art to modify the joint ball of Ersoy et al to have the plastic ring as taught by Nishino et al for replaceably embedding the magnet therein. This also allows for the pieces of the structure to be produced independently from each other and then secured together without directly securing the magnet to the joint ball.

As to Claim 2. Ersoy et al disclose said magnet having front sides and is directly in contact by one of said front sides with said ball pivot.

As to Claim 3. Ersoy et al disclose said magnet being cylindrical or truncated cone-shaped.

As to Claim 4. Ersoy et al disclose said recess being cylindrical.

As to Claims 19 and 20. Ersoy et al disclose said ball pivot consisting entirely of ferromagnetic material, especially ferromagnetic steel.

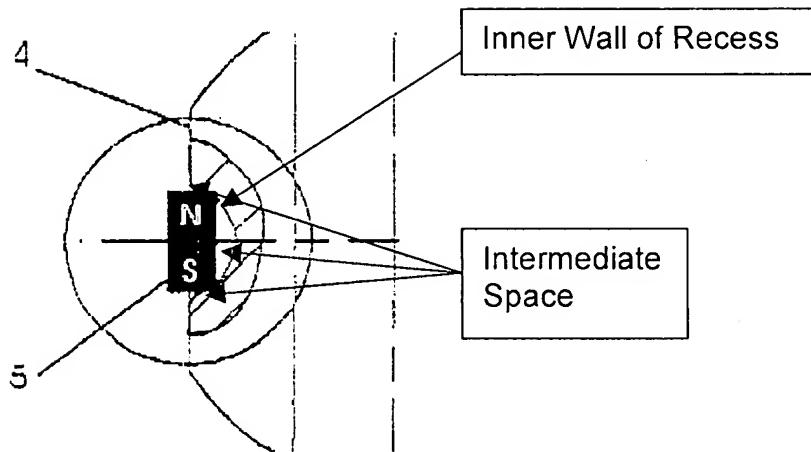
Claims 1-7 and 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse.

As to Claims 1, 5-7, 21, 23, 26 and 28. Kruse discloses a ball and socket joint for a motor vehicle, the ball and socket joint comprising:

a ball and socket joint housing (6);  
a ball pivot (Fig 1) which is mounted rotatably and pivotably in said housing and has a pivot (9) and a joint ball (2) connected thereto, and  
a magnet (5) having a jacket surface (the outer surface), the ball pivot having a recess (See Examiners Figure below) with said magnet arranged therein, an intermediate space (See Examiners Figure below), is formed between said jacket surface of said magnet and an inner wall of said recess.

However, Kruse does not explicitly disclose the intermediate space being filled with a nonmagnetic material completely shaped as a hollow cylinder, completely arranged within said recess, to fix said magnet. Kruse does teach that the permanent magnet is "mounted in a recess" (Col 3, Lines 47-48). It is a well-known engineering principle that one structure can be mounted to another via some sort of adhesive or glue. Therefore it would have been obvious to one of ordinary skill in the art to partially fill the recess with a glue (or some other adhesive) to mount the magnet within the recess, thus filling the hollow, cylindrical intermediate space with a non-magnetic material.

Examiner's Figure



As to Claim 2. Kruse discloses said magnet having front sides and is directly in contact by one of said front sides with said ball pivot (Fig 1).

As to Claim 3. Kruse discloses said magnet being cylindrical or truncated cone-shaped (Fig 1)..

As to Claim 4. Kruse discloses said recess being cylindrical (Examiner considers the recess to be cylindrical at the juncture between the magnet and the joint ball).

As to Claims 19, 20 and 25. Kruse discloses said ball pivot being formed of a ferromagnetic material in an area of said recess (Fig 1).

As to Claims 22 and 27. Kruse discloses said magnet projects out from a surface of said non-magnetic material (Fig 1).

As to Claim 24 and 29. Kruse discloses a maximal outer diameter of said nonmagnetic material is equal to or less than said diameter of said recess (Fig 1).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 2, 21 and 26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11, 13 and 14 of copending Application No. 10/568,851. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The copending application claims all of the patentable features of Claims 1, 2, 21 and 26 of the instant application

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 19-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/568,851 in view of Kruse. The copending application claims all of the patentable features of the instant application but does not disclose the magnet projecting out from a surface of the plastic.

Kruse teaches a similar ball joint having a magnet embedded in a ball joint and projecting outwardly from a surface of the plastic for better detection by the field sensors within the ball housing (Col 1, Lines 43-60 and Col 2, Lines 5-9). It would have been obvious to modify the magnet of the instant application to have the magnet projecting outwardly from a surface of the plastic as taught by Kruse for better detection by the field sensors within the ball housing

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-7 and 19-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of US Patent 7170285 and claims 1-23 of US Patent 7159890 in view of Kruse. The aforementioned patents claims all of the patentable features of the instant application but do not disclose the magnet projecting out from a surface of the plastic.

Kruse teaches a similar ball joint having a magnet embedded in a ball joint and projecting outwardly from a surface of the plastic for better detection by the field sensors within the ball housing (Col 1, Lines 43-60 and Col 2, Lines 5-9). It would have been obvious to modify the magnet of the instant application to have the magnet projecting outwardly from a surface of the plastic as taught by Kruse for better detection by the field sensors within the ball housing.

#### ***Response to Arguments***

Applicant's arguments filed 8/23/2007 have been fully considered but they are not persuasive.

As to the Claims, Applicants argue:

"Applicant finds no reason in the prior art why producing the pieces of the structure independently from each other is, by itself, beneficial in Ersoy, or why then securing them together without directly securing the magnet to the joint ball is beneficial in Ersoy... It is applicant's position that, by itself, producing the plastic ring independently provides no benefit at all to a person of ordinary skill" (Pages 8-9).

Examiner respectfully disagrees and notes the recent Supreme Court decision on KSR Int'l Co. v. Teleflex, Inc., NO 04-1350 (U.S. Apr. 30, 2007) that during the examination of a patent "it will be necessary... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**" *KSR*, slip op. at 14 (emphasis added). In other words, it is only necessary to show that there was an apparent reason for the combination and that the motivation for combination need not be for the same reason as in the instant application; and, as admitted by Applicant on Page 8 of the response, the independent production of the pieces of the structure provide a benefit to the combination. Also, Examiner adds that this separate production would allow for easier replacement of the magnet (than if it were glued into the ball joint as seen in prior art), if such a situation should arise, since the magnet is press fit into the plastic piece which is subsequently press fit into the assembly. Per those examples, the "apparent reason" to combine the known elements is to have independent production of the pieces of the structure which would allow for easier replacement of the magnet which satisfies the requirements as set forth under 35 USC 103.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTK  
9/12/2007

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